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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/921,480

08/03/2001

Lenzie Borders

11694/04099

7260

27483

7590

05/18/2004

CALFEE, HALTER & GRISWOLD, LLP
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CLEVELAND, OH 44114

EXAMINER

NGUYEN, DINH Q

ART UNIT

PAPER NUMBER

3752

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,480

Applicant(s)

BORDERS ET AL.

Examiner

Dinh Q Nguyen

Art Unit

3752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11</u> _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4, 12, 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 12 and 13 of copending Application No. 09/921465. Although the conflicting claims are not identical, they are not patentably distinct from each other because of common subject matter, as follows:

Claim 1 of the amendment dated March 05, 2004 cites a material application system comprising a user input device remotely located from a manufacturing site, a configuration program accessible over a communication network, the configuration program presenting component selection options based on input data from the user, and the configuration program also verifying component compatibility, which are fully disclosed in claim 1 of the copending Application No. 09/921465.

Furthermore, claim 1 of the copending Application No. 09/921465 is broader and discloses all the limitations of the amended claim 1 of this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 6 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Jahn et al.

Jahn discloses a system for configuring a spraying application system comprising user input device 160 remotely located from a manufacturing site 132/136, a configuration accessible by the user input device over a communication network 169, the configuration program 342 (figure 6a and 6b, and column 6, line 60 to column 7, line 15), and a pricing and inventory database 372 (figures 7a and 7b).

With respect to claims 6 and 7, the apparatus shown by Jahn is capable of performing the method or steps recited in the claim.

Claims 1, 2, 4, 6, 7, 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Madden et al.

Madden discloses a system for configuring a spraying application system comprising a user input device 212, a configuration program accessible by the user input device over a communication, the configuration presenting component selection options based on input

data from the user input device and verifying component compatibility (figure 2, column 14, line 62 to column 23, line 17), an internet connection (column 16, line 53), and using secure websites via known commercial solution such as Internet Explorer™ and Netscape Navigator™ which present secure connections.

With respect to claims 6 and 7, the apparatus shown by Madden is capable of performing the method or steps recited in the claim.

5. Claims 1,4, 6, 7, 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Friel et al.

Friel discloses a system for configuring a spraying application system comprising a spraying application system, a user input device 131/132/133 located remotely from the manufacturing location, a configuration program accessible by the user input device over a communication network, the configuration program presenting component selection options based on input data from the user input device, the configuration program verifying component compatibility (paragraph 28-33). Furthermore, the claimed limitations are disclosed through out the whole application.

With respect to claims 6 and 7, the apparatus shown by Friel is capable of performing the method or steps recited in the claim.

Response to Arguments

6. Applicant's arguments filed March 05, 2004 have been fully considered but they are not persuasive. The Friel, Madden, and Jahn are capable of performing the configuration of the claimed paint application system. Furthermore, a recitation of the intended use of the claimed invention must result in detailed structural differences between the claimed

invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

7. Applicant's arguments with respect to claims 1-4, 12 and 13 have been considered but are moot in view of the new ground(s) of rejection.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinh Q Nguyen whose telephone number is 703-305-0248. The examiner can normally be reached on Mon-Fri 6:30-4:00 alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on 703-308-2087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dinh Q Nguyen
Primary Examiner
Art Unit 3752

dqn